REMARKS

This responds to the Office Action mailed on <u>March 22, 2007</u>.

Claims 16, 19, 22-24, 27-30, 33-36, and 39 are amended, no claims are canceled, and no claims are added; as a result, claims 16- 39 are now pending in this application. The amendments are fully supported by the instant specification and do not introduce any new matter.

§103 Rejection of the Claims

Claims 16-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Padgett et al. (U.S. 6,167,518, hereinafter "Padgett") in view of Ross (U.S. 6,195,447), and further in view of Beetcher et al. (U.S. 5,933,497, hereinafter "Beetcher"), and further in view of Cane et al. (U.S. 5,416,840, hereinafter "Cane"). Applicant respectfully submits that, in light of the amendments, a *prima facie* case of obviousness cannot be established because, even if combined, the cited references fail to teach or suggest all of the elements of Applicant's claimed invention. The reference (or references when combined) must teach or suggest all the claim elements. [1]

Amended claim 16 recites, in pertinent part "receiving at least one response from the user computer, the at least one response including a first computer fingerprint file and a first identification for the user, said first computer fingerprint file including at <u>least one identifying characteristic of the user computer</u>." The Office Action at page 3 Concedes, " Padgett et al ('518) does not explicitly disclose the feature of . . . receiving at least one response from the user computer, the at least one response including a first fingerprint file and a first identification for the user." However, the Office Action asserts that Ross (Col. 3, lines 56-59) discloses theses claim feature. *Id* The cited passage was analyzed in a previous response. [2] In that passage, what is received is a scanned fingerprint image, which according to Fig. 1 in Ross, is a human fingerprint, and not *a computer fingerprint file*. Accordingly, the fingerprint file in Ross can

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[1]. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991))

[2] Response mailed 4/13/2005, page 8

only identify a person and not a computer, as required by the amended claim 16 feature of *said*

first computer fingerprint file including at least one identifying characteristic of the user

computer. Moreover, Applicant cannot find any other passage in Ross that teaches this claim

feature. As such, Ross does not teach or suggest the limitation of, "*receiving at least one*

response . . . one response including a first computer fingerprint file . . . said first omputer

fingerprint file including at least one identifying characteristic of the user computer," as recited

in the amended claim 16.

> Amended claim 16 further recites:
>
> comparing the first computer fingerprint file against a second computer
> fingerprint file, <u>to verify the user computer,</u> the second computer fingerprint file
> accessible by the verification computer, said second computer fingerprint file
> including at least <u>one identifying characteristic of a user computer;</u>

The Office Action at page 3 asserts that Ross discloses corresponding previous claim 16 feature

at column 4, lines 1-7. As argued in a previous response,[3] the passage only describes processing

a fingerprint image to gain access to a secure area. However, the fingerprint image in Ross, as

discussed above, is only a human fingerprint image, thus, is not the same as the *computer finger*

print file and is not compared with *a second computer fingerprint file* to *verify the user*

computer. Thus, the passage does not teach "*comparing the first computer fingerprint file*

against a second computer fingerprint file, to verify the user computer. . . said second computer

fingerprint file including at least one identifying characteristic of a user computer," as recited in

the amended claim 16.

> Amended claim 16 also includes:
>
> sending at least one verification response to the computer, based upon the
> comparing of the first computer fingerprint file against the second computer
> fingerprint file and upon the comparing of the first identification for the user
> against the second identification for the user;

The Office Action, at page 3, alleges that Ross discloses the corresponding previous claim 16

feature at column 4, lines 25-27. The passage states "The comparator generates a verification

signal for transmission . . . to the access mechanism to admit or deny entry to the secured area."

However, the verification signal in Ross is the result of comparing two finger print images

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[3] Response mailed 4/13/2005, pages 8 and 9

(human fingerprint) and not *the first computer fingerprint file against the second computer fingerprint file,* as required by the amended claim 16. In addition, the fingerprint images in Ross could only be used to identify a person and not a *user computer,* as the amended claim 16 requires. In sum, Ross does not teach or suggest, *"sending a verification response to the computer based upon the comparing of the first computer fingerprint file against the second computer fingerprint file . . .,"* as recited in the amended claim 16.

With respect to Cane, the Office Action at page 2 states that Cane reference is cited as identifying the user computer. Applicant respectfully submits that the Examiner did not consider the claimed invention as a whole and only focused on the claim preamble. In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. [4] In order for Cane to cure the deficiency of Padgett and Ross, it needs to be established that Cane teaches all claim features argued above with respect to the identification of user computer. Clearly, it is not sufficient for Cane to teach only the user computer identification, it must disclose the user computer identification through the same method steps as recited in the amended claim 16. Cane is directed to a method and system for protecting computer program distribution within a broadcast medium involving encrypting a portion of the computer program Si using an encryption scheme keyed to both an encryption key SKi and a program identifier i. (Abstract) Cane specifically discloses:

> The method involves encrypting at least a portion of the computer program Si using an encryption scheme keyed to both an encryption key SKi and a program identifier i. . . . Two tables are generated and stored in a memory device: a first table, including correlations between the encryption key SKi and the program identifier i; and a second table, including correlations between a password key PKj and the hardware identifier j. . . . The user-transmitted program identifier i is used to access the software encryption key SKi from the first table, and the user-transmitted hardware identifier j is used to access the password key PKj from the second table. A password Pij is generated based on both the encryption key SKi

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[4] *Stratoflex, Inc. v. Aeroquip Corp.,* 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.,* 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983); *Interconnect Planning Corp. v. Feil,* 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985); MPEP § 2141.02.

and the password key PKj. The password Pij is transmitted to the user for
subsequent use in decrypting the selected software program Si contained on the
medium.
(Col.2, lines 20-55)

In the above passage, the user transmits a program identifier i and a hardware identifier j. Cane
then uses the identifiers i and j, respectively, to access a software encryption key and a password
key stored in a first and a second tables and, based on the accessed keys, generates a password
and sends the password to the user. However, the passage is silent on *a second computer
fingerprint file including at least one identifying characteristic of a user computer.* In addition,
using a hardware identifier j to access a password key from a table is not the same as *comparing
the first computer fingerprint file against a second computer fingerprint file, to verify the user
computer,* as required by the amended claim 16. Thus, cane in the quoted passage does not teach
"*comparing the first computer fingerprint file against a second computer fingerprint file, to
verify the user computer. . . said second computer fingerprint file including at least one
identifying characteristic of a user computer,*" as recited in the amended claim 16. Moreover,
sending a password, created based on the accessed keys, to the user by Cane, is not the same as
the claimed feature of *sending at least one verification response to the computer.* Because, first
of all, the user in Cane does not send a verification request to a verification computer; thus, is not
the same as "*the computer*" in the amended claim 16, which is the computer from which the
request for verification was received by the verification computer. Secondly, the password sent
to the user is not the same as *a verification based upon the comparing of the first
computer fingerprint file against the second computer fingerprint file,* as required by the amended
claim 16. As such, Cane does not teach or suggest the feature of, "*sending at least one
verification response to the computer, based upon the comparing of the first computer
fingerprint file against the second computer fingerprint file and upon the comparing of the first
identification for the user against the second identification for the user,*" as recited in the
amended claim 16.

The Office Action at page 4 alleges that Beetcher discloses the claimed invention (by
previous claim 16) except for a second fingerprint file. The Office Action does not point to any
passage in Beetcher that disclose the previous claim 16 features discussed above. Beetcher is
directed at distributing a software without entitlement to run and separately distributing

encrypted entitlement key to enable the execution of the software. In order for the combination of Padgett, Ross, Cane, and Beetcher to teach each and every element of the amended claim 16, Beetcher should teach what is lacking in Padgett, Ross, and Cane. However, Applicant could not find any passage in Beetcher that teaches or suggests the claim features discussed above. Consequently, at least for the reasons set forth above, Padgett, Ross, Cane, and Beetcher, individually or in the combination fail to teach or suggest each and every element of the amended claim 16.

     As such, Applicant respectfully submit that the amended independent claim 16 and its dependent claims 17-33 are allowable and it is requested the claim rejections under 35 U.S.C. § 103(a) be reconsidered, in light of the amendments, and withdrawn.

     Claim 34 recites, "a processor for communicating with the storage unit and the memory unit to compare information indicative of the second computer fingerprint file and the second identification for the user with information indicative of the first computer fingerprint file and the first identification file for the user." The Office Action asserts Padgett teaches the corresponding previous claim 34 features in the passages at column 2, lines 61-67 and column 3 lines 1-6. Padgett's passage at column 2, line 61 to column 3, line 6 states:

> The digital representation of the registrant's biological indicia is encrypted using the registrant's private key and sent to the certificate authority along with the registrant's public key. The certificate authority decrypts the digital representation and stores it. The registrant then visits a remote registration terminal in person with the digital representation and other identifying documents. The operator of the remote registration terminal verifies the identity of the registrant from the identifying documents and transmits the digitized representation to the certificate authority. The certificate authority compares the decrypted digital representation with the representation sent from the remote registration terminal.

This passage describes comparing two items. The certificate authority compares decrypted biological information with information sent from a remote terminal. However, claim 34's processor compares four items. In particular, claim 34's processor is to compare information indicative *of the second computer fingerprint file and the second identification for the user with* information indicative of *the first computer fingerprint file and the first identification for the user.* Therefore, this passage does not teach or suggest the processor of claim 34. Applicant cannot find any other passages in Ross that teaches this claim feature.

Claim 34 recites, "a storage unit to receive information indicative of a first computer fingerprint file and a first identification for the user, said first computer fingerprint file including at least one identifying characteristic of the user computer." Claim 34 also recites, "a memory unit to receive information indicative of a first computer fingerprint file and a first identification for the user, said first computer fingerprint file including at least one identifying characteristic of the user computer." The Office Action asserts that Ross discloses the corresponding previous claim 34 features at column 3, line 56-59. The passage in Ross states:

> At the local site 40, a processor 42 receives the scanned fingerprint image data
> from the scanner 32 across the transmission line 26 and acts to locate the real time
> discrete topographical minutia points.
> (Col. 3, lines 56-59)

This passage clearly does not teach or suggest the claimed storage and memory units. The Office Action at page 7 admits that Padgett does not explicitly disclose said fingerprint file being comprised of at least one identifying characteristic of the user computer. However, the Office Action asserts that Cane discloses said fingerprint file being comprised of at least one identifying characteristic of the user computer. In order for Cane to cure the deficiency of Padgett and Ross, it needs to be established that Cane teaches all claim features argued above with respect to the identification of the user computer. Clearly, it is not sufficient for Cane to teach only the user computer identification, it must disclose the user computer identification using the claimed elements. The Office Action does not show and Applicant could not find any passage in Cane that teaches or suggests these claim features.

The Office Action at page 7 alleges that Beetcher discloses the claimed invention (by previous claim 34) except for a second fingerprint file. The Office Action's position assumes that the claimed invention has merely added a second fingerprint file to a well-known device. However, the amended claimed invention includes *the second computer fingerprint file*, *a storage unit to receive information indicative of a second computer fingerprint file*, and *a processor* for performing operations based on the *second computer fingerprint file*. As such, the amended claimed invention does not merely duplicate the essential working parts of a device, creates a patentable clearing house computer. For the combination of Padgett, Ross, Cane, and Beetcher to teach each and every elements of claim 34, Beetcher must teach what Padgett, Ross, and Beetcher are lacking. The Office Action does not point to any passage in Beetcher that

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disclose the claim features discussed above. Applicant could not find any passage in Beetcher that teaches or suggests the claim features either. As such, at least for the reasons noted above, Padgett, Ross, Cane, and Beetcher, individually or in the combination fail to teach or suggest each and every element of the amended claim 34.

Therefore, Applicant respectfully submit that amended independent claim 34 and its dependent claims 35-39 are allowable and it is requested the claim rejections under 35 U.S.C. § 103(a) be reconsidered, in light of the amendments, and withdrawn.

OFFICIAL NOTICE

Applicant objects to the Examiner's taking Official Notice in claims 21, 22, 25, 31, 33, and 39. Applicant respectfully requests that the Examiner provide references supporting the concepts for which Official Notice is taken.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney 408-278-4042 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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